

FAX

GlaxoSmithKline

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Date February 28, 2006 Pages including cover 25
Response to Decision on Petition Under 37 CFR
1.42

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Serial No.: 10/524,470

Date:

Applicant: Eatherton et al.

Title: Pyrimidine Derivatives and Their Use as CB2 Modulators

Attached:

Transmittal Letter to the United States Designated/Elected Office....
Petition for Extension of Time Under 37 CFR 1.136(a)
Response to the Decision on Petition Under 37 CFR 1.42
Declarations (6 pages) *2
Power of Attorney & Correspondence Indication Form
Resolution

Certificate of Transmission

RECEIVED

28 FEB 2006

Legal Staff
International Division**Certificate of Transmission by Facsimile (37 CFR 1.8)**

I hereby certify that this Response is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. 571-273-0459) on February 28, 2006.


Valerie L. Phillips

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FORM PTO-1390 (Modified) U.S. PATENT AND TRADEMARK OFFICE; U.S. DEPARTMENT OF COMMERCE
(REV. 7-2005)

ATTORNEY'S DOCKET NUMBER

P33099USW

TRANSMITTAL LETTER TO THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)
CONCERNING A SUBMISSION UNDER 35 U.S.C. 371

U.S. APPLICATION NO. (If known, see 37 CFR 1.5)

10/524,470

INTERNATIONAL APPLICATION NO.

PCT/EP03/09217

INTERNATIONAL FILING DATE

August 19, 2003

PRIORITY DATE CLAIMED

August 21, 2002

TITLE OF INVENTION

Pyrimidine Derivatives and Their Use As CB2 Modulators

APPLICANT(S) FOR DO/EO/US

EATHERTON, Andrew, John; GIBLIN, Gerard, Martin, Paul; GREEN, Richard, Howard (Deceased); MITCHELL, William, Leonard; NAYLOR, Alan; RAWLINGS, Derek, Anthony; SLINGSBY, Brian, Peter; WHITTINGTON, Andrew, Richard

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☐ This is a **FIRST** submission of items concerning a submission under 35 U.S.C. 371.
2. ☒ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a submission under 35 U.S.C. 371.
3. ☐ This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include Items (5), (6), (9) and (24) indicated below.
4. ☐ The US has been elected (Article 31).
5. ☐ A copy of the International Application as filed (35 U.S.C. 371 (c)(2))
 - a. ☐ is attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ has been communicated by the International Bureau.
 - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☐ An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)).
 - a. ☐ is attached hereto.
 - b. ☐ has been previously submitted under 35 U.S.C. 154(d)(4).
7. ☐ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371 (c)(3))
 - a. ☐ are attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ have been communicated by the International Bureau.
 - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
 - d. ☒ have not been made and will not be made.
8. ☐ An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
9. ☒ An oath or declaration of the inventor(s) (35 U.S.C. 371 (c)(4)).
10. ☐ An English language translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371 (c)(5)).
11. ☐ A copy of the International Preliminary Examination Report (PCT/IPEA/409).
12. ☒ A copy of the International Search Report (PCT/ISA/210).

Items 13 to 23 below concern document(s) or information included:

13. ☒ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
14. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
15. ☒ A **FIRST** preliminary amendment.
16. ☐ A **SECOND** or **SUBSEQUENT** preliminary amendment.
17. ☐ A substitute specification.
18. ☒ A power of attorney and/or change of address letter.
19. ☐ A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821 - 1.825.
20. ☐ A second copy of the published International Application under 35 U.S.C. 154(d)(4).
21. ☐ A second copy of the English language translation of the International Application under 35 U.S.C. 154(d)(4).
22. ☐ Express Mail Label No.

PTO-1390 (Rev. 07-2005)

Approved for use through 3/31/2007. OMB 0651-0021

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.


U.S. APPLICATION NO (if known, see 37 CFR 1.5)		INTERNATIONAL APPLICATION NO.		ATTORNEY'S DOCKET NUMBER	
10/524,470		PCT/EP03/09217		P33099USW	
23. Other items or information:					
The following fees have been submitted:				CALCULATIONS PTO USE	
24. <input type="checkbox"/> Basic national fee				\$300	\$0.00
25. <input type="checkbox"/> Examination fee (37 CFR 1.492(c))					
If the written opinion of the ISA/US or the international preliminary examination report prepared by IPEA/US indicates all claims satisfy provisions of PCT Article				\$0	\$0.00
All other situations.				\$200	
26. <input type="checkbox"/> Search fee (37 CFR 1.492(b))					
If the written opinion of the ISA/US or the international preliminary examination report by IPEA/US indicates all claims satisfy provisions of PCT Article 33(1)-(4).				\$0	
Search fee (37 CFR 1.445(a)(2)) has been paid on the international application to the as an International Searching Authority.				\$100	\$0.00
International Search Report prepared by an ISA other than the US and provided to the previously communicated to the US by the IB.				\$400	
All other situations.				\$500	
TOTAL OF 24, 25 and 26 =				\$	\$0.00
<input type="checkbox"/> Additional fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing in compliance with 37 CFR 1.821(c) or (e) or computer program listing in an electronic medium) (37 CFR 1.492(j)). The fee is \$250 for each additional 50 sheets of paper or fraction thereof.					
Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof (round up to a whole)		RATE	
- 100 =	0 /50 =	0		x \$250.00	\$0.00
Surcharge of \$130.00 for furnishing any of the search fee, examination fee, or the oath or declaration after the date of commencement of the national stage (37 CFR 1.492(h)).				\$	\$130.00
CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE		
Total claims	- 20 =	0	x \$50.00	\$	\$0.00
Independent claims	- 3 =	0	x \$200.00	\$	\$0.00
MULTIPLE DEPENDENT CLAIMS (If applicable) <input type="checkbox"/> + \$360.00				\$	\$0.00
TOTAL OF ABOVE CALCULATIONS =				\$	\$130.00
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Fees above are reduced by 1/2.				\$	\$0.00
SUBTOTAL =				\$	\$130.00
Processing fee of \$130.00 for furnishing the English translation later than 30 months from the earliest claimed priority date (37 CFR 1.492(l)).				\$	\$0.00
TOTAL NATIONAL FEE =				\$	\$130.00
Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40 per property +				\$	\$0.00
TOTAL FEES ENCLOSED =				\$	\$130.00
				Amount to be	\$
				Amount to be	\$

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- a. ☐ A check in the amount of \$ _____ to cover the above fees is enclosed.
- b. ☒ Please charge my Deposit Account No. 07-1392 in the amount of \$ \$130.00 to cover the above fees.
A duplicate copy of this sheet is enclosed.
- c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1392. A duplicate copy of this sheet is enclosed.
- d. ☐ Fees are to be charged to a credit card. **WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

NOTE: Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the International Application to pending status.

SEND ALL CORRESPONDENCE TO:


SIGNATURE
J. Scott Young
NAME
45,582
REGISTRATION NUMBER
28 Feb 2006
DATE

P33099USW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Eatherton et al.

Serial No.: 10/524,470

Filing Date:

Title: Pyrimidine Derivatives and Their use as CB2
Modulators

PCT Legal Administration
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Renewed Submission Under 37 CFR 1.42

Sir:

In response to the Decision on Petition Under 37 CFR 1.42 mailed January 18, 2006,
Applicants respectfully submit the enclosed substitute Declaration (2 documents) in
compliance with 37 CFR 1.42 and 1.497(a) and (b).

Respectfully submitted,



J. Scott Young
Attorney for Applicants
Registration No. 45,582

Date: 28 Feb 2006
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